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Paper No. 15  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Schnee-Morehead Business Trust

Serial No. 75/745,609

Kay Lynn Schwartz of Gardere Wynne Sewell LLP for Schnee-Morehead Business Trust.

Julie A. Watson, Trademark Examining Attorney, Law Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Cissel and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Schnee-Morehead, Inc., by the above-identified application, applied to register the phrase WARM APPLIED CURABLE ACRYLIC for goods identified, following amendment, as "adhesive sealants for aircraft, aerospace, automotive, building construction, architectural, major appliances, plastics and related uses,"<sup>1</sup> in International Class 17. The

<sup>1</sup> The identification is exactly as it read when the application was filed, but for an amendment that added the word "adhesive." The examining attorney noted in an Office action that such amendment was accepted, but the word "adhesive" was never entered

intent-to-use application was amended to assert first use and first use in commerce as of September 1999. In addition, the application was assigned to Schnee-Morehead Business Trust.<sup>2</sup>

The specimen of use submitted by applicant with the amendment to allege use is a label for a container for applicant's goods. The label is headed by a stylized S-M® (for Schnee-Morehead) and lists the product as Perma Bed 2000™, with a description of the product as "A Curing Fenestration Sealant." The description of the product is followed by the following phrase "'PRODUCTS TO STICK WITH'®." The label also includes certain warnings, information regarding use of the product and disposal of empty containers, and contact information for applicant. On the lower right side of the label, there appears the designation WACA™ TECHNOLOGY (with WACA in much larger bold-face type) and, below that, the phrase WARM APPLIED CURABLE ACRYLIC (with the first letter of each of these words set forth in slightly larger bold-face type, but with no "TM" designation appended thereto).

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into the Office's database. The Board shall make the entry. Also, though the examining attorney, in the identification in her brief, omits the word "aerospace," this appears to be an oversight. The term remains part of the identification.

<sup>2</sup> Assignment recorded in the Office's assignment records at Reel 2039, Frame 955, February 9, 2000.

The Examining Attorney refused registration of WARM APPLIED CURABLE ACRYLIC (set forth in typed form in the application drawing) under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), on the ground that the phrase applicant seeks to register is merely descriptive of the goods identified in the application.

Applicant responded to the refusal with arguments in support of registration. When the refusal was made final, applicant appealed and filed a request for reconsideration, resulting in a stay of the appeal. The examining attorney, however, was not persuaded of applicant's right to registration and maintained the final refusal. The appeal was resumed and applicant and the examining attorney have filed briefs. Applicant did not request an oral argument.

The record consists of certain excerpts from the NEXIS database of newspaper and periodical articles, excerpts from the LEXIS/NEXIS database of patent information, a reprint from applicant's own website in regard to the goods, and a dictionary definition of "cure," all of these having been put into the record by the examining attorney; and informational printouts from the Office's database in regard to 14 registrations for marks which applicant asserts contain the term "acrylic," put into the record by applicant.

The following statements from her appeal brief aptly summarize the Examining Attorney's position:

In the present case, the applicant's goods are sealants made from curable acrylic that are applied at a warm temperature. The mark [sic] WARM APPLIED CURABLE ACRYLIC immediately conveys to potential purchasers what applicant's goods are made of (curable acrylic) and how they are to be used (applied warm). Further, the fact that the terms CURABLE and ACRYLIC may have several meanings is not relevant here. It is the significance the words have with regard to the identified goods that controls.

In addition, the examining attorney asserts that the registrations proffered by applicant are not probative of the registrability of applicant's phrase because, of the 14 registered marks, only two contain the word "acrylic," and one of these two has expired.<sup>3</sup>

The examining attorney, in each of her three office actions, and in her brief, has made essentially the same assertion, i.e., that applicant's product is a curable acrylic that is applied warm. In addition, the examining attorney has noted that applicant's own website refers to its product in a descriptive manner, as "a warm-applied curing acrylic sealant."

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<sup>3</sup> Of the 12 registrations discounted by the examining attorney, we note that one, for the mark ACRYLICLEAN, though a telescoped combination of ACRYLIC and CLEAN, can be viewed as containing the term "acrylic." The other 11, however, only have a root or portion of the word.

Applicant has not, in any response or brief, denied either the accuracy of the examining attorney's repeated characterization of applicant's goods or that the statement on its own website aptly describes its goods. Rather, applicant relies on inflated but largely inapposite arguments. Specifically, applicant argues that "cure" and "acrylic" can have a wide variety of meanings so that prospective purchasers or users of applicant's product "would be forced to use a great deal of imagination to ascertain the exact nature of the goods"<sup>4</sup>; that even if the individual components of the asserted mark are descriptive, the combination may not be; that a term or phrase can be ever so close to being "merely" descriptive but so long as it can still be more properly termed suggestive than descriptive, then it should be registered; and that there is a fine line between suggestive marks and descriptive

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<sup>4</sup> Apart from referring to various dictionary definitions to show the myriad meanings these two terms can have, applicant also relies on the 14 registrations it introduced into the record to establish that "acrylic" cannot be descriptive—and must be held suggestive. Applicant theorizes that the term cannot be descriptive "because there are so many goods with which acrylic can be associated." The theory fails because "acrylic" is a term used in a *descriptive* sense in the identification of each of the registrations, not in a *suggestive* sense in each of the marks. As noted, the term does not even appear in 11 of the 14 marks; it is disclaimed in one of the three in which it does appear, and is not subject to a disclaimer in another of these three, i.e., in ACRYLICLEAN, because it is a telescoped mark. See TMEP §1213.04(a). That the term "acrylic" appears in one registered mark without being subject to a disclaimer is not probative

terms and, whenever there is doubt, the Office must resolve doubt in favor of finding the term or phrase suggestive rather than descriptive.

The test for mere descriptiveness under Section 2(e)(1) of the Lanham Act is well settled. A term or phrase is merely descriptive of the goods with which it is used and, therefore, not entitled to registration, if it immediately conveys information about a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bright-Crest, Ltd.*, 2001 USPQ 591 (TTAB 1979).

The record makes it abundantly clear that adhesive sealants can be made of acrylic and be curable, or, put another way, used in such a manner that they are subject to curing after application or use. We see no significant difference between referring to such a product as a "curable acrylic" sealant or, as put in the description on applicant's website, a "curing acrylic" sealant. Either phrase is an apt description of the nature of applicant's product. We are not persuaded otherwise by applicant's attacks on the NEXIS excerpts as possible "careless" uses

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evidence that the term is suggestive when used on or in connection with other goods or services.

of the terms shown in the excerpts or by the suggestion that the NEXIS evidence consists of "regurgitation of casual references" to the terms.

Clearly, there are some references that are inapposite, because the goods discussed in those references are different than applicant's goods, e.g., the references to acrylic coatings rather than adhesive sealants. Others, however, are clearly probative and unmistakable evidence of descriptive uses of the terms therein. Applicant argues, in part, that some of the NEXIS references to sealants discuss products that are used to "fill cracks" whereas applicant's "caulking compound ... is a compound used to fill or close seams." We see no significant difference in these applications. Moreover, even if we were to disregard the majority of the NEXIS evidence, we still would be faced with applicant's website, which perhaps contains the most direct evidence of the descriptiveness of WARM APPLIED CURABLE ACRYLIC. The phrase would still be considered merely descriptive even if applicant were the only one to use it descriptively in connection with the specified goods. *National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

Notably, applicant makes no argument that the term "warm applied" does not describe the precise manner in

which its product must be applied. We find persuasive the examining attorney's argument that the record shows that many curing adhesive sealants are applied hot and one feature of applicant's product, that it touts on its website, is the ability to apply applicant's product when it is only warm, rather than hot, which makes the product easier to work with and quicker to cool and cure.

No imagination is required in order to understand the nature of the goods from consideration of the term "curable acrylic" or the manner of use of the goods from consideration of the term "warm applied," when these terms are used together in connection with the goods.<sup>5</sup> That different meanings would be ascribed to the words that make up applicant's phrase in other circumstances is not determinative of the issue before us in this appeal, which is whether the phrase is merely descriptive in connection with the goods specified in the application. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)(consideration of proposed mark "when applied to the goods" is required by the statute); see also, *In re Bright-Crest*, supra. Though applicant asserts that the

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<sup>5</sup> We do not find the examining attorney to have "dissected" applicant's mark by considering, separately, the significance of "curable acrylic" and "warm applied." It is clear that the examining attorney has considered, as have we, the ultimate question of registrability of the phrase as a whole.



combination of terms may result in a non-descriptive, registrable phrase, we perceive no incongruence or double entendre that is created by combining the descriptive words into a phrase; and applicant does not suggest any theory whatsoever why the combination results in a registrable mark.

In this case, we have no doubt to resolve. The entire phrase is merely descriptive when used in conjunction with applicant's goods and, contrary to applicant's contention, would not require any thought or imagination by a prospective consumer to understand the description.

Decision: The refusal to register is affirmed.